D. REMARKS

Specification

Applicants have amended the specification above to include the application serial numbers of the related cross-references.

Amendments to Claims

Claims 4 and 19 are amended for purposes of clarification. Claims 38 and 39 are cancelled.

Claim 40 is added. In particular, claim 40 includes the elements of claim 1 and includes an element with antecedent basis on page 35, lines 19-26 which describes requiring caller tariffs when the caller blocks the caller's ID from transfer to the destination line.

35 USC § 103(a)

Claims 1-39 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Herling (U.S. Patent 6,504,918) in view of Truchon et al. (U.S. Patent 6,144,723) or Albers et al. (U.S. Patent 6,636,504). Applicants note that the Examiner carries the burden of proving a prima facie case of obviousness for a 103(a) rejection. Because the Examiner does not prove a prima facie case of obviousness for claims 1-37, Applicants respectfully request withdrawal of the rejection and allowance of the claims.

Claim 1

Claim 1 currently reads:

1.**(Currently Amended)** A method for billing for a call, said method comprising:

initiating a request to bill a caller a tariff for a call, wherein said caller originates said call;

prompting said caller to accept payment of said tariff to receive access to a destination line during said call; and

responsive to negotiating said payment of said tariff from said caller to pay a callee at said destination line, connecting said caller with said destination line, such that said caller pays for access to said destination line.

Regarding claim 1, the Examiner cites Herling, col 3, lines 15-35, col. 4, lines 40-50, col. 5, lines 10-65, and col. 6, lines 1-43 as teaching the method for "billing a call by using backward tariffing transferring billing amounts from the calling party to the called party such that the caller pays for access." [Office Action, p. 2] However, the Examiner notes that the difference between Herring and the claimed invention is "the use of specific negotiation." [Office Action, p. 2] The Examiner also notes that "it is believed that the claim limitations as constructed read on the ubiquitous 900 services" referenced in Chet (U.S. Patent 5,978,775; col. 4, lines 15-25) or "calling part plays" referenced in Rhodes (U.S. Patent 6,529,726; abstract) or "any direct long distance dialing in which the calling party accepts charges." [Office Action, pp. 2-3] The Examiner cites Truchon et al, Figs 2-4c and col. 6, lines 59-68 or Albers et al, Fig. 7 and col. 5, lines 55-65 as showing "a billing negotiation process for telephone voice transactions." [Office Action, p. 3] And, the Examiner concludes that "it would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Herling because the billing means are conventional functional equivalents." [Office Action, p. 3]

In applying 35 U.S.C. 103, the test is whether the claimed invention, when considered as a whole would have been obvious. *See, e.g. Jones v. Hardy*, 200 U.S.P.Q. 1021, 1024 (Fed. Cir. 1984). Thus, it is impermissible to focus either on the "gist" or "core" of the invention (*Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 230 U.S.P.Q. 416, 420 (Fed. Cir. 1986), *cert. denied*, 484 U.S. 823 (1987). Applicants note that in the rejection of claim 1, the Examiner limits the difference between Herring and the claimed invention to a particular gist of Herring

lacking "the use of specific negotiation." [Office Action, p. 2] Herring's "negotiation" is controlled by an operator and requires both parties to agree with the tariff while already on the line with one another (Col. 6, lines 1-43). In contrast, when viewed as a whole, the claimed invention teaches limiting a caller's access to a destination line until a tariff is paid. The present invention solves the problem of how to require a caller to pay a tariff for access to the callee line, in contrast with the combination of Herring with other automated negotiation services that only solves the problem of how to exchange a tariff when a call is already commenced. Further, when the invention is viewed as a whole, the claimed invention teaches tariffing where only the caller is involved in the transaction, but Herring in contrast requires the caller and the callee both participate in the tariff transaction. Thus, Applicants respectfully assert that distilling the differences between Herring and the claimed invention down to "the use of specific negotiation" disregards the problem of how to limit a caller access to a destination line number and how to perform caller-focused tariff application. Therefore, because the Examiner does not show how, when considered as a whole, the claimed invention would have been obvious, Applicants respectfully request withdrawal of the rejection and allowance of the claim.

In addition, in establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). In applying 35 U.S.C. 103, the Examiner states that Herring teaches "billing a call by using backward tariffing transferring billing amounts from the calling party to the called party such that the caller pays for access." [Office Action, p. 2] Applicants respectfully note that Herring only teaches facilitating access to a service or data after a backward tariff is agreed to, but that a communication channel between the caller and the callee at the destination line is already established when the actual tariff is applied (Col. 5, lines 1-6: "Between the calling party and the called party there exists a transparency communication channel – such as a telephone connection between the calling party and the called party in the telephone network of Deutsche Telekom. The calling and the called parties have agreed that forward or backward tariffing should take place via the telecommunications network.") Applicants respectfully note, however, that the claimed invention teaches that even though the

caller has initiated a call to a destination line, the caller does not access the destination line until after the tariff is negotiated. Therefore, because Herring does not teach what the Examiner claims it teaches, the combined prior art references also do not teach or suggest all the claim limitations, and in particular do not teach or suggest the limitation of "responsive to negotiating said payment of said tariff from said caller, connecting said caller with said destination line, such that said caller pays for access to said destination line."

Further, Applicants traverse the Examiner's note that "it is believed that the claim limitations as constructed read on the ubiquitous 900 services, or calling part pays, or any direct long distance dialing in which the calling party accepts charges" [Office Action, p. 3] In particular, Applicants note that the Examiner's references are not indicated in the general rejection under 35 USC 103 and it is not apparent whether the Examiner is rejecting the claims on the basis of "ubiquitous 900 services, etc." or whether the Examiner is merely citing relevant art.

Claims 2-15

Claims 2-15 are dependent claims of independent claim 1, which should be allowed. Thus, Applicants respectfully request allowance of claims 2-15 as dependent claims of an allowable independent claim. In addition, Applicants note that even if claim 1 is not allowable, claims 4 and 14-15 are not obvious and should be allowed.

Claim 4

Regarding claim 4, the Examiner cites Herling col. 3, lines 15-35, col. 4, lines 40-50, col. 5, lines 10-65, and col. 6, lines 1-43 as teaching a "method for billing a call by using backward tariffing including invoice process which is a functional equivalent of the claim limitations." [Office Action, p. 3] Claim 4 currently reads:

4.**(Currently Amended)** The method for billing for a call according to claim 1, wherein said request to bill a caller is [received] <u>initiated</u> in response to a tariff offer in a caller profile.

First, Applicants note that claim 4 is currently amended to clarify that "said request" referred to in claim 4 derives antecedent basis from "a request" in claim 1 and that "said request" in claim 4 is the same request "initiated" in claim 1. In particular, Applicants delete "received" and add "initiated" to clarify that it is the request for a tariff that is initiated in response to the tariff offer in the caller profile.

Second, in establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). Applicants respectfully assert that the combined prior art references do not teach or suggest the limitations of the amended claim, and therefore that amended claim 4 should be allowed. In particular, applicants note that the Examiner cites the limitation of "wherein said request to bill a caller is received in response to a tariff offer in a caller profile" as a "backward tariffing including invoice process". [Office Action, p. 3] The "invoice process described in Herling, however, merely describes the process of verifying that the caller and the callee have agreed on "the amount to be invoiced to the calling party, how the amount is to be invoiced" (Col. 6, lines 10-12), sending a reminder of the tariffing, and controlling the transfer of the amount received from the calling party to the called party. (Col. 4, lines 40-50: "In the case of backward tariffing, this circuit arrangement controls the invoicing and, whenever necessary, the sending of a reminder for the calling party; and in the case of forward tariffing, it controls the transfer of the payment received from the called party to the calling party. From the point of view of the called party (terminal 6), in the case of forward tariffing, circuit arrangement/ apparatus 4 controls the invoicing and, whenever necessary, the sending of a reminder to the called party; and in the case of backward tariffing, it controls the transfer of the amount received from the calling party to the called party.") Nowhere does Herling described an "invoice" process that includes initiating a tariff in response to accessing a

tariff offer in the caller profile. Further, Herling only describes initiating a backward tariffing service responsive to the calling party signaling the terminal that the backward tariffing service is to be used (Col. 5, lines 11-13). Therefore, because the Examiner does not establish that Herling teaches the limitations of claim 4, particularly as amended for clarification, Applicants respectfully request allowance of amended claim 4.

Claims 14 and 15

Regarding claims 14 and 15, the Examiner cites Herling, col. 3, lines 15-35, col. 4, lines 40-50, col. 5, lines 10-65, and col. 6, lines 1-43. Herling col. 3, lines 15-35 describes forward and backward tariffing, using an operator as an intermediary to control the tariff charges. Col. 4, lines 40-50 describe the controls for invoicing for forward and backward tariffing. Col. 5, lines 10-65 and col. 6, lines 1-43 describe the signals processes used parties to consent to forward and backward tariffing through the operator intermediary.

Claims 14 and 15 current read:

> 14.(Original) The method for billing for a call according to claim 1, further comprising:
>
> negotiating a payment of a tariff for forwarding said call to an alternate destination device.
>
> 15.(Original) The method for billing for a call according to claim 1, further comprising:
>
> refunding at least a portion of said tariff to said caller.

In establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20

USPQ2d 1438 (Fed Cir. 1991). Applicants respectfully assert that the Examiner does not point out how Herling as combined with the other prior art references, teaches or suggests all the claim limitations of claims 14 and 15, and therefore respectfully request allowance of claims 14 and 15.

In particular, with regard to claim 14, Applicants respectfully assert that Herling does not describe an operator assisted negotiation of a tariff for forwarding the call to an alternate destination device than the destination device originally called. In contrast, claim 14 recites an element of "negotiating a payment of a tariff for forwarding said call to an alternate destination device."

In addition, in particular, Applicants respectfully assert that Herling does not describe refunding any portion of a tariff to a caller. In contrast, claim 15 recites an element of "refunding at least a portion of said tariff to said caller."

Therefore, because Herling does not teach negotiating a payment to forward a call to an alternate destination device or refunding a portion of the tariff to the caller, Herling does not teach or suggest all the claim limitations and the Examiner does not establish prima facie obviousness for claims 14 and 15.

Claims 16-30

Claims 16-30 are closely parallel in elements and rejections to claim 1-15, respectively. Claim 16, in particular, is parallel to claim 1, and should be allowed for the same reasons as asserted by Application for allowance claim 1. Claim 17-30 are dependent upon an allowable independent claim and Applicants request allowance of these dependent claims.

Applicants note, in particular, that claim 19 is parallel to claim 4 and is amended for purposes of clarification in the same manner as claim 4. Additionally, Applicants respectfully request allowance of claim 19 for the same reasons as asserted by Applicants for allowance of claim 4.

Further, Applicants note, in particular, that claims 29 and 30 are parallel to claims 14 and 15 and respectfully request allowance of claims 29 and 30 for the same reasons as asserted by Applicants for allowance of claims 14 and 15.

Claims 31-37

Claims 31-37 are closely parallel in elements and rejections to claim 1-3, 9, and 13-15, respectively. Claim 31, in particular, is parallel to claim 1, and should be allowed for the same reasons as asserted by Application for allowance claim 1. Claim 32-37 are dependent upon an allowable independent claim and Applicants request allowance of these dependent claims.

Applicants note, in particular, that claims 36 and 37 are parallel to claims 14 and 15 and respectfully request allowance of claims 36 and 37 for the same reasons as asserted by Applicants for allowance of claims 14 and 15.

Conclusion

Applicants note the citation of pertinent prior art cited by the Examiner.

In view of the foregoing, withdrawal of the rejections and the allowance of the current pending claims is respectfully requested. If the Examiner feels that the pending claims could be allowed with minor changes, the Examiner is invited to telephone the undersigned to discuss an Examiner's Amendment. Further, Applicants reiterate the request for a telephone conference with the Examiner at the Examiner's earliest convenience.

Respectfully submitted,

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Amy J. Pattillo
ATTORNEY FOR APPLICANTS
Reg. No. 46,983
P.O. Box 161327
Austin, Texas 78716
512.402.9820 [phone]
512.306.0417 [fax]